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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,444	06/09/2006	Hartmut S. Engel	LA-7690-102/10506586	6382
167 7590 01/09/2008 FULBRIGHT AND JAWORSKI LLP 555 S. FLOWER STREET, 41ST FLOOR LOS ANGELES, CA 90071			EXAMINER ZETTL, MARY E	
			ART UNIT 2875	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/541,444

Applicant(s)

ENGEL, HARTMUT S.

Examiner

Mary Zettl

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on not filed is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/05 and 7/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Regarding claim 1, in line 2, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Claim Objections***

2. Claims 4-20 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not refer to any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

### ***Drawings***

3. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing under 37 CFR 1.81(c). No new matter may be introduced in the required drawing. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). For purposes of examination the drawings of PCT/EP04/13335 have been utilized.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muggenburg (EP 1 033 530 A2) in view of Jongewaard et al. (US 6,561,670 A).

Regarding claim 1, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Therefore, the limitation of line 2, "in a room ceiling" has not been taken into account.

Regarding claim 1, Muggenburg teaches a built-in lamp comprising a bulb (7) and a reflector (3), with a reflector opening disposed in the direction of illumination defining a direct light discharge region (referring to Figure 1 direct light discharge region is region between the surfaces of item 3 and under item 5) which is surrounded by a diffuse light discharge region (the area under items 21a and 21b; Figure 1) such that scattered light is discharged from the diffuse light discharge region around the direct light discharge region, characterized in that the bulb (7) and the direct light reflector (3) are arranged in a housing (15, 17a, 17b) whose inner surface is made at least regionally as an additional reflector; and a translucent scattering plate (21a and 21b) in the region of the diffuse light discharge region (region under items 21a and 21b).

Muggenburg teaches the lamp being utilized as an installation lamp (paragraph 27 of translation taken from espacenet). Muggenburg does not disclose expressly a holder for fastening the lamp to an installation surface. Jongewaard et al. teaches a built-in light including a holder for fastening the lamp to an installation surface (col. 2, lines 63-67). At the time the invention was made it would have been obvious to one of ordinary skill in the art to have modified the invention of Muggenburg such that a holder for fastening the lamp to an installation surface as taught by Jongewaard et al. was provided since it is well known that in order for the lamp to be installed in a location some form of holder for fastening the lamp must be provided in order to provide protection to the lamp.

Muggenburg teaches plates 21a and 21b spanning the light diffusion region. Muggenburg not disclose expressly the housing being terminated in at least a largely dust-proof manner by the plates 21a and 21b and furthermore does not disclose a plate within opening 5. Jongewaard et al. teaches the lamp being terminated in a largely dust-proof manner (col. 4, lines 36-42). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to have modified the invention of Muggenburg such that the lamp was terminated in a largely dust-proof manner as taught by Jongewaard et al. in both the direct light output region and the diffuse light discharge region in order to maximize the life of the lamp by preventing damage due to contaminants.

Regarding claim 2, Muggenburg teaches the direct light discharge region (area under item 5) and the diffuse light discharge region (area under items 21a and 21b) can be acted on by a common bulb (7).

Regarding claim 3, Muggenburg teaches the reflector opening (5) defining the direct light discharge region and being associated with a direct light reflector (3) on whose side remote from the direct light discharge region (region under item 5) an additional reflector or background reflector (17a, 17b, 15) is provided.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Zettl whose telephone number is 571-272-6007. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandy O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2875

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*4m3*

MZ

*Sharon Payne*  
SHARON E. PAYNE  
PRIMARY EXAMINER